



The Intellectual Property Law Section of the State Bar of California presents the **32nd Annual Intellectual Property Law Institute**

REGISTER ONLINE BY VISITING WWW.CALBAR.CA.GOV/IPSECTION



monterey

November 8-10, 2007

Monterey Marriott

350 Calle Principal
at Del Monte Boulevard
Monterey, California 93940
831.649.4005

- Enjoy an exceptional line-up of topics and speakers presenting on substantive IP topics, ethics, elimination of bias and more!
- Earn up to 17.00 hours of MCLE credit (includes .50 Legal Ethics Credit)
- Network, share ideas and learn the latest with Intellectual Property professionals with diverse experience and backgrounds.
- A full 2 days of continuing education for a nominal fee of \$495 for members of the Intellectual Property Law Section includes education programs, program materials, Friday and Saturday continental breakfasts and luncheons, Thursday dessert reception, and the Friday Casino Night
- Bonus Nuts & Bolts session on Thursday, November 8, 2007

SPONSORS:

The Intellectual Property Section would like to thank the following sponsors for their financial support:

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The State Bar of California and the Intellectual Property Law Section of the State Bar of California are approved MCLE Providers.

2007 IP Institute Planning Committee

Barbara Friedman, *Chair*
Hanson, Bridgett, Marcus, Vlahos, & Rudy
J. Alison Grabell, *Vice-Chair*
Venable LLP

programs at a glance

THURSDAY, NOVEMBER 8, 2007

TRACK I – Patent	TRACK II – Trademark	TRACK III - Copyright
Nuts and Bolts of Patent Prosecution and Litigation	Nuts and Bolts of Trademark Prosecution, Litigation, and Licensing	Nuts and Bolts of Copyright Prosecution, Litigation, and Licensing

FRIDAY, NOVEMBER 9, 2007

TRACK I - Patents	TRACK II - Mixed
Best Practices in I.P. Licensing (General Session)	
Drugs and Biologic Patents	Property Rights in Video Games
How Patents Suppress Speech	Copyright Year in Review
Re-Examination Strategies	Dilution Law
Patent Examination Pitfalls, Staying Current with Office Changes, and Practice Tips	Trademark Year in Review
Does One Size Fit All? IP Rules for a Diverse Economy—(General Session)	

SATURDAY, NOVEMBER 10, 2007

TRACK I - Patents	TRACK II - Mixed
Impact of <i>KSR</i> and <i>Microsoft v. AT&T</i>	Anatomy of a Publishing Contract
New Patent Legislation and PTO Rule Changes	Trademark Prosecution Tips from the Trenches
Patent Law Update	Clearances and Permissions: You Can Do It!
Q & A with Congressman Darrell Issa on Patent Reform	Piracy: Injunctive Relief
Trademark & Patent Trolls—(General Session)	

schedule of events

THURSDAY, NOVEMBER 8, 2007

9:00 a.m. – 2:00 p.m.

Executive Committee Meeting

2:00 p.m. – 5:00 p.m. (3.00 Hours MCLE Credit)

Concurrent Sessions (includes 15 minute break)

TRACK I – PATENTS

Nuts and Bolts of Patent Prosecution and Litigation Practice

Attorneys experienced in this field will present a program on the basics of patent prosecution and litigation practice designed for new admittees, practitioners new to the field of law, and paralegals.

Panelists: Joseph R. Baker, Buchanan Ingersoll & Rooney PC
Bryan J. Sinclair, Buchanan Ingersoll & Rooney PC

TRACK II – TRADEMARKS

Nuts and Bolts of Trademark Prosecution, Litigation, and Licensing

Attorneys experienced in this field will present a program on the basics of trademark prosecution, litigation, and licensing practice designed for new admittees, practitioners new to the field of law, and paralegals.

Panelists: Barbara L. Friedman, Hanson Bridgett et al.
J. Alison Grabell, Venable LLP
Mary A. Harris, Attorney at Law
Christine L. Kopitzke, Attorney at Law
Thomas Speiss, Baker & Hostetler LLP

Track III - COPYRIGHTS

Nuts and Bolts of Copyright Prosecution, Litigation and Licensing
Attorneys experienced in this field will present a program on the basics of copyright prosecution, litigation, and licensing practice designed for new admittees, practitioners new to the field of law, and paralegals.

Panelists: Neil A. Smith, Sheppard Mullin Richter & Hampton LLP
Cydney A. Tune, Pillsbury Winthrop Shaw Pittman LLP

5:00 p.m. – 6:00 p.m.

Law Student Reception—Open to Everyone

7:00 p.m. – 9:00 p.m.

Annual Executive Committee Alumni and Speakers' Reception & Dinner ([by invitation](#))

9:00 p.m. – 11:00 p.m.

Kick-off Party Dessert Reception

REGISTER ONLINE:

www.calbar.ca.gov/ipsection

32nd Annual Intellectual Property Law Institute
November 8-10, 2007 | Monterey Marriott



schedule of events

FRIDAY, NOVEMBER 9, 2007

7:00 a.m. - 7:45 a.m.

Continental Breakfast & Conference Registration

7:45 a.m. - 8:00 a.m.

Opening Remarks

8:00 a.m. - 9:00 a.m. (1.00 Hour MCLE Credit)

GENERAL SESSION

Best Practices in IP Licensing

Three licensing experts share their negotiating and drafting insights for maximizing value and minimizing liability exposure across a wide range of licensing transactions. This beyond-the-basics presentation is designed to provide licensing tools that intellectual property practitioners of all disciplines will find useful.

Panelists: Karen Ballack, Weil, Gotshal & Mages LLP
Kevin D. DeBré, Stubbs Alderton & Markiles, LLP
Michael Plumleigh, Critical Path, Inc.

9:00 a.m. - 10:00 a.m. (1.00 Hour MCLE Credit)

TRACK I - PATENTS

Drugs & Biologic Patents

Mr. Donovan will present an introduction to various types of pharmaceutical patents, regulatory (FDA granted) exclusivities and product-patent life cycle management for improved patient benefits. Mr. Baker will discuss aspects particular to the licensing of pharmaceutical patents as well as the effect KSR and recent PTO Rule changes may have on life sciences patents.

Panelists: Joseph R. Baker, Buchanan Ingersoll & Rooney PC
Stephen Donovan, Allergan, Inc.

TRACK II - MIXED

Property Rights in Video Games

As virtual worlds grow in popularity, they raise a number of legal issues. Among the most persistent and interesting issues are whether and to what extent the law should recognize "property" rights in virtual objects and avatars, and whether and to what extent that law should enforce end-user license agreements (EULAs) that may contradict the reasonable expectations of the users. The former raises questions of intellectual property law and property theory, and the latter raises questions of contract law and regulatory theory. This session will explore the need for and limits of legal regulation of virtual worlds.

Speaker: Tyler T. Ochoa, Santa Clara University Law School

10:00 a.m. - 10:15 a.m.

Break

10:15 a.m. - 11:30 a.m. (1.25 Hours MCLE Credit)

TRACK I - PATENTS

How Patents Suppress Speech

Every day, more and more citizens are using new communications tools and software to exercise their First Amendment rights

online. At the same time, the number of patents on internet communication technologies has increased dramatically. Judicial decisions issuing or denying injunctions on the use of these technologies may dramatically impact online speech. This session will review the tension between patents and online speech and discuss how courts can manage this tension by analyzing injunctive relief in light of already established speech doctrines.

Panelists: Corynne McSherry, Electronic Frontier Foundation
Jason Schultz, Electronic Frontier Foundation

TRACK II - MIXED

Current Developments in Copyright

The program will review the most significant copyright decisions of the past twelve months, illustrated with numerous visual and audio examples. Topics will include copyrightability and substantial similarity in visual works, termination and misuse, the display right in the internet context, secondary liability, fair use, first sale, the Visual Artists Rights Act, and joint ownership.

Speaker: Robert Clarida, Cowan, Liebowitz & Latman, P.C.

11:30 a.m. - 12:30 p.m. (1.00 Hour MCLE Credit)

TRACK I - PATENTS

Re-Exam Strategies

This presentation will concentrate on practical considerations in determining whether to file a request for reexamination and, if so, whether one should select *ex parte* or *inter partes* reexamination (if the latter is available). The presentation will also include suggestions as to what to include in the request.

Speaker: Robert G. Mukai, Buchanan Ingersoll & Rooney PC

TRACK II - MIXED

Dilution Law

This session will review development in dilution law since the enactment of the 2006 Trademark Dilution Revision Act, including application of the "fame" factors, fair use, and early trends in the courts.

Speaker: David Welkowitz, Whittier Law School

12:30 p.m. - 2:00 p.m. (1.00 Hour MCLE Credit)

Luncheon & Keynote Program

Victoria A. Espinel, Assistant Trade Representative for Intellectual Property and Innovation, Office of the United States Trade Representative

The United States and the World: Negotiating Intellectual Property Protection



Ms. Espinel will address international intellectual property-related issues, foremost among them international trade negotiations and agreements regarding protection and enforcement of intellectual property and their impact on the practice of Intellectual Property Law.

schedule of events

2:15 p.m. - 3:30 p.m. (1.25 Hour MCLE Credit)

TRACK I - PATENTS

Patent Examination Pitfalls, Staying Current with Office Changes and Practice Tips

Join the panelists for a discussion of their top 10 list of examination pitfalls and tips to overcome them. In addition, a brief overview of initiatives at the PTO will be included.

Panelists: *Margaret A. (Peggy) Focarino, Deputy Commissioner for Patent Operations*
Robert Clarke, Director of the Office of Patent Legal Administration
Robert J. Spar, Retired, Former Director of Office of Patent Legal Administration, USPTO

TRACK II - MIXED

Trademark Year in Review

The panelists will survey the year's noteworthy trademark decisions and developments, and the foreseeable impact of these developments.

Panelists: *Sophie Cohen, Cobalt LLP*
Nate Andrew Garhart, Coblenz Patch et al. LLP

3:30 p.m. - 5:00 p.m. (1.50 Hour MCLE Credit)

GENERAL SESSION

Does One Size Fit All? IP Rules for a Diverse Economy

The patent and copyright laws create a general set of rules that govern inventions and creativity for a huge number of different technologies and media. Patent law, for example, applies the same governing principles to semiconductors as business methods. Copyright law subjects the \$50 million motion picture and the \$0.02 shampoo bottle label to the same basic legal regime. Does this make any sense? A wealth of economic research shows that different industries operate according to vastly different innovation cultures. Should we maintain our current one-size fits all IP system? Or should we embark on a process of customizing IP rules to more closely fit different industries' particular innovation practices?

Panelists: *Dan Burk, University of Minnesota Law School*
Michael Carroll, Villanova University School of Law
Christopher Sprigman, University of Virginia School of Law

6:00 p.m. - 8:30 p.m. (.50 Hour MCLE Legal Ethics Credit)

Reception/Dinner with Sean Carter, Esq., Humorist



In this hilarious presentation, Mr. Carter explores some of the more outrageous disciplinary cases that come before state bar committees and how lawyers can avoid being part of them.
\$50 per person

9:00 p.m. - 12 midnight

Monte Carlo Casino Night

Let the gaming begin—'cause you're playing to win! Nothing beats the heart pounding excitement of real life casino action. Guests will enjoy blackjack, craps, roulette, and Texas hold'em. Of course, it's not real gambling. It's all for fun. But there will be prizes, too! Complimentary (indicate attendance on the registration form)

SATURDAY, NOVEMBER 10, 2007

7:30 a.m. - 4:00 p.m.

Registration

7:30 a.m. - 8:30 a.m.

Continental Breakfast

8:15 a.m. - 8:30 a.m.

Opening Remarks

8:30 a.m. - 9:30 a.m. (1.00 Hour MCLE Credit)

TRACK I - PATENTS

The Impact of KSR and Microsoft v. AT&T

Panel discussion on the dramatic impact of *KSR v. Tencor* and *Microsoft v. AT&T* on patent prosecution, patent litigation and patent licensing strategies. Panel members with patent prosecution, patent litigation and in-house experience will share their thoughts in the post-KSR and *Microsoft v. AT&T* era.

Panelists: *Georgann Grunebach, DIRECTV Enterprises Inc.*
David Randall, Jones Day
T.J. Singh, Klein, O'Neill & Singh

TRACK II - MIXED

The Anatomy of a Book Publishing Agreement

This session will provide a comprehensive and practical review of the real world of book publishing agreements. It will focus on the balance of rights and obligations between authors and publishers and reveal both "money leaks" and "artistic control leaks" in typical agreements. Mr. Pimm will discuss mainstream publishing agreements as well as hybrids such as print-on-demand service agreements.

Speaker: *Robert G. Pimm, Law Office of Robert G. Pimm*

9:30 a.m. - 11:00 a.m. (1.50 Hour MCLE Credit)

TRACK I - PATENTS

New Patent Legislation and PTO Rule Changes

The status of Patent Reform legislation will be discussed along with its impact on both patent prosecution and litigation strategies. In this climate of change, the US Patent and Trademark Office continues to implement rule changes that impact practice before the Office. Highlights of recent rule changes will also be presented.

Panelists: *Benjamin Borson, President, Borson Law Group, PC*
Teresa Stanek Rea, Buchanan Ingersoll & Rooney PC
Charles Van Horn, Finnegan Henderson

schedule of events

TRACK II—MIXED

Trademark Prosecution: Tips from the PTO Trenches

USPTO attorneys will provide useful strategies for successfully navigating the examination process. This will be a panel discussion in which practitioners may participate in an open dialogue about USPTO practices and procedures.

Panelists: James B. (Brett) Golden, U.S. Trademark Office
April L. Rademacher, U.S. Trademark Office

Moderator: Jefferson F. Scher, Carr & Ferrell LLP

11:00 a.m. – 11:15 a.m.

Break

11:15 a.m. – 12:15 p.m. (1.00 Hour MCLE Credit)

TRACK I—PATENTS

Critical Patent Law Developments 2006-2007

A panel discusses key Federal Circuit and Supreme Court decisions rendered since last Fall's IP Institute; what is expected to happen next year at the Supreme Court; litigation and procurement implications of *KSR*; post-*MedImmune* DJ and licensing practice; *Vonage* and other post-*eBay* injunctive relief; and current, breaking case developments

Panelists: Jared Ben Bobrow, Weil Gotshal & Manges LLP
Bryan J. Sinclair, Buchanan Ingersoll & Rooney PC
Harold C. Wegner, Foley & Lardner LLP

TRACK II—MIXED

Clearances and Permissions: You can do it!

This session will provide a discussion of the clearance process for licensing and use of copyrighted material, including an overview of the basic rights involved and strategies for clearances. The presentation will also include a discussion of clearance strategies and issues that are unique to specific types of copyrighted works such as music, text, photographs, and artwork. Public domain works and fair use issues will also be addressed.

Speaker: Cydney A. Tune, Pillsbury Winthrop Shaw Pittman LLP

12:15 p.m. – 1:00 p.m.

Standing Committee Luncheon Meetings

Each Standing Committee meeting listed below is open to any Institute registrant. Please select the committee luncheon you wish to attend by checking the appropriate box on the registration form.

Copyright Law
Legislation
Licensing
Patent Law

1:00 p.m. – 1:45 p.m.

Standing Committee Luncheon Meetings

Computer Law
Trademark Law
Trade Secret Law

1:45 p.m. – 2:45 p.m. (1.00 Hour MCLE Credit)

TRACK I—PATENTS

Q&A with Congressman Darrell Issa on Patent Reform



Congressman Issa will discuss many of the issues raised in the patent reform debate. Topics will include apportionment of damages, post grant review and the impact of Supreme Court decisions upon the patent community. The Congressman's experience with patent litigation in the private sector provides him with a unique perspective on the implications of proposed changes to patent law.

Speaker: Honorable Darrell Issa,
Representative R-CA 49th District

TRACK II—MIXED

Piracy: Injunctive Relief from the Trenches

Piracy of products, software and brands is an expensive reality facing business owners. The headlines are filled with stories about piracy from the Viacom v. Google matter and the US government's litigation before the WTO against China, to piracy litigation over toys, videos, handheld computers, photography and music. Anti-piracy litigation, both in U.S. Courts and before the WTO, can be fast-paced and requires a specific skill set. Litigators and business lawyers can better assist their clients to fight and defend against piracy by understanding the tools of injunctive relief. This discussion will examine effective use of the TRO, seizure orders, cease and desist letters, take down notices and alternative dispute resolution and will discuss the importance of understanding the marketplace for and business incentives to engage in or challenge piracy.

Panelists: Richard Idell, Idell Seitel LLP
Michael Page, Kecker & Van Nest LLP
Gregory Alan Rutchik, The Arts and Technology Law Group

2:45 p.m. – 3:45 p.m. (1.00 Hour MCLE Credit)

GENERAL SESSION

Taking a Page from the "Patent Troll" Playbook: A Business Model for Trademark?

The panelists will provide a brief description of the history of the "patent troll" business model and those who created it and excelled at it. They will then discuss the efforts of Leo Stoller to extend this business model to trademark litigation over a 10-year period. The panelists will discuss the rules in place at the PTO and in the courts that allowed Mr. Stoller to continue despite consistent losses and numerous sanctions, and whether these rules should be revised or changed.

Panelists: Lance G. Johnson, Roylance, Abrams, Berdo & Goodman, L.L.P.
Thomas Speiss, Baker Hostetler, LLP
Cary Tope-Mckay, Tope-McKay & Associates

Conference Adjourns

registration information

the Intellectual Property Law Section welcomes all who are interested in Intellectual Property. You need not be a lawyer to attend, enjoy and benefit from this program.

REGISTRATION FEES:

Registration fees include admission to 1700 hours of MCLE instruction, course materials, continental breakfasts, luncheons, the Thursday dessert reception, and the Friday evening Casino Night.

CANCELLATIONS:

All requests for refunds must be received in writing no later than **October 26, 2007**. Refunds will be issued less a \$50 non-refundable administrative cost. Refunds will not be available after the October 26th deadline; however, registration substitutions are accepted.

SPECIAL ASSISTANCE:

Please call (415) 538-2585 for special assistance or TDD (415) 538-2231 for speech and hearing impaired registrants.

HOTEL RESERVATIONS AT MONTEREY MARRIOTT:

We have reserved a limited block of sleeping rooms at the Monterey Marriott in Monterey. Please contact the hotel directly at (800) 228-9290 (Worldwide Marriott) or (831) 649-4234 (Reservations Monterey Marriott) to make your reservation. Please identify yourself as part of the State Bar of California Intellectual Property Institute to obtain the special rate of \$219 single/double plus occupancy tax per night. Please make your reservation by **October 17, 2007**. Reservations made after the **October 17, 2007** deadline will be made on a space available basis at the confirmed group rate.

INFORMATION:

For more information, please call the Intellectual Property Law Section at (415) 538-2375. For registration information, please call Program Registrations at (415) 538-2508.



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three WAYS TO REGISTER!

- Online:** Register online by visiting
www.calbar.ca.gov/ipsection
- Fax:** You may fax your registration form to
Program registrations at (415) 538-2368.
All faxed registrations must be
accompanied by a signature and
MasterCard or VISA card number.
- Mail:** Mail registration form and check made
payable to the State Bar of California or
credit card information to: Program
Registrations, The State Bar of California,
180 Howard Street, San Francisco, CA 94105.

Note: One registrant per form. Photocopies may be used.

Bar Number: _____

Name: _____

Firm Name: _____

Firm Address: _____

City, State & Zip: _____

Phone: _____

Fax: _____

E-mail: _____

(Required for e-mail confirmation)

Guest: _____

(Note: if your guest is a non-attorney, registration is complimentary for non-ticketed events. Attorney guests must complete a separate registration form and pay the appropriate registration fee.)

- ☐ Check here if you do not want your information released to other IP Institute attendees and exhibitors/vendors.

REGISTRATION FEES (check the appropriate box):

- ☐ \$495 IP Section Members
- ☐ \$595 Non-Members of the Intellectual Property Law Section (includes enrollment in the Intellectual Property Law Section for 2008)
- ☐ \$215 Law School Faculty and Paralegals
- ☐ \$50 Law Students

Subtotal of Registration Fee \$ _____

SPECIAL EVENTS:

Thursday, November 8

Law Student Reception

- ☐ I will attend ____ (# in party) FREE

Kick-off Party

- ☐ I will attend ____ (# in party) FREE

Friday Luncheon (free for PAID registrants)

- ☐ I will attend FREE

Number of Guests - Friday Luncheon

_____ @ \$35 = \$ _____

Friday Dinner with Sean Carter

- ☐ I will attend _____ @ \$50 = \$ _____

Monte Carlo Casino Night

- ☐ I will attend ____ (# in party) FREE

Saturday Committee Luncheon

- ☐ I will attend FREE

(indicate below which Committee luncheon you will attend)

12:15 p.m. - 1:00 p.m.

- ☐ Copyright Law
- ☐ Legislation
- ☐ Licensing
- ☐ Patent Law

1:00 p.m. - 1:45 p.m.

- ☐ Computer Law
- ☐ Trademark
- ☐ Trade Secret

Subtotal of Special Events Fee \$ _____

Total Amount Enclosed or to be charged \$ _____

PAYMENT METHOD:

Registration fees may be paid by check, VISA or MasterCard. No other credit cards will be accepted. Make checks payable to the State Bar of California.

- ☐ VISA ☐ MasterCard

Account Number: _____

Expiration Date: _____

Cardholder's Name: _____

Cardholder's Signature: _____

**FOR REGISTRATION INFORMATION
PLEASE CALL (415) 538-2508**

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State Bar of California

Intellectual Property Law Section
180 Howard Street
San Francisco, CA 94105-1639

Non-Profit Org
U.S. Postage
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Documentation

REGISTER ONLINE BY VISITING:

www.calbar.ca.gov/ipsection

Hotel Registration Deadline:

October 17

Registration Deadline:

October 26